



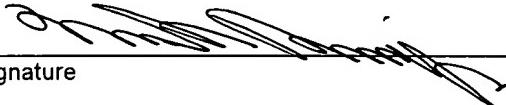
1661
11/10/03
hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail
in an envelope addressed to: Commissioner of Patents, USPTO, P.O. Box 2327 Arlington, VA, D.C. 22202; on

December 21, 2002

Date

Mark Bourgeois

Typed or Printed Name of Person Mailing Paper or Fee


Signature

12/20/2002

Date of Signature

RECEIVED

JAN 02 2003

TECH CENTER 1600/2900

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In RE:

Serial no.: 09/944,932
Filing date: 08/31/2001
For: Euphorbia Plant named 'Charam'
Inventor: Tickner
Atty. Docket no.: PH39
Group Art Unit: 1661
Examiner: Para

Honorable Commissioner of Patents and Trademarks
Washington, D.C. 20231

RESPONSE

Dear Sir:

This is in response to the Office Action dated 11/05/2002. No additional fees are believed to be necessary.

Rejection under 35 U.S.C. 102b:

The claim was rejected under 35 USC 102b as being anticipated by Plant Breeders Right grant number 03000204 in view of 'Charam' being sold in the United Kingdom.

The combination of a non-enabling printed publication with foreign commercial use is not a bar to patentability under 35 U.S.C. 102(b) for plant patents. Every element of a new plant variety can not be disclosed in a printed publication. A non-enabling publication fails as a reference under 102(b). The cited printed publication does not contain every material element of the claimed invention.

Further, foreign public or commercial activity fails as a barring activity under 102(b). Combining these two "non-references" to make a rejection under 102(b) is not proper.

In order to properly reject the claim under 35 U.S.C. 102(b), every element of the claimed invention must be found in a single reference, as required under *LeGrice*. In the present case, the cited Plant Breeder's Rights certificate was taken in combination with the sale in the United Kingdom as being sufficient to bar patentability. Therefore, the reference was not a single reference and rejection under 102(b) is improper.

It is respectfully requested that the 102b rejection be withdrawn.

The claimed plant is now believed to be in condition for allowance.

Respectfully submitted,



Mark P. Bourgeois
Reg. No. 37,782